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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/700,005      | 11/03/2003  | Andrew Bartlett      | MCA-460D US         | 3640             |

25182 7590 10/19/2005  
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| EXAMINER |
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ORTIZ, ANGELA Y

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| ART UNIT | PAPER NUMBER |
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1732

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/700,005

Applicant(s)

BARTLETT ET AL.

Examiner

Angela Ortiz

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27 and 29-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50-52 is/are allowed.
- 6) ☒ Claim(s) 27, 29-49 and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The amendment filed November 26, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: The drawing filed November 26, 2004 was not part of the original application, as set forth in the petition decision of November 19, 2004. The Example 1 described in the specification cannot be understood without reference to the drawing as the points on the graph were not included in the specification, therefore the drawing is new matter. Because the drawing is a graph of example 1 results, and unrelated to the claimed subject matter and figures 1-9, no claim rejections will be made based on the new matter.

Applicant is required to cancel the new matter in the reply to this Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27, 29-39, 43-48, 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims include a Markush group that includes "thermoplastics"; this is indefinite as "thermoplastics" is a property and not a species as currently claimed.

Art Unit: 1732

Claim 53 is an incomplete claim. Note that no art rejection is made because the claim is not complete.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27, 39, 40, 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Wyatt et al., USP 3,679,059 for the reasons cited in the previous office action.

The cited reference teaches the claimed method of providing a filter 11 having holes 19-22, each of which are sealed by thermoplastic material 15,16 around at least a portion of the hole. The periphery of the filter is provided with a gasket material. See col. 3, lines 35-70.

With respect to the newly claimed Markush group for the elastomeric material, item 15, 16 of the cited reference is polypropylene, and is a thermoplastic polymer material.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1732

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 29-35, 41-42, 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyatt et al., USP 3,679,059 in view of Leason, USP 4,113,627 for the reasons cited in the previous office action.

The cited primary reference teaches the basic claimed method of providing a filter 11 having holes 19-22, each of which are sealed by thermoplastic material 15,16 around at least a portion of the hole. The periphery of the filter is provided with a gasket material. See col. 3, lines 35-70.

The cited primary reference does not teach the use of a mold or injection molding as claimed.

The added secondary reference teaches as conventional a method comprising the steps of providing a filter 86 within an aperture 77 of a filter housing part 76. Positioning rings 81 are located around aperture 76 for properly positioning the filter in

Art Unit: 1732

place. A mold 84, 85 is fitted onto part 76 for molding thermoplastic seals 91 around the periphery of the aperture. See col. 8, lines 58-68; col.9, lines 1-20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to so include an injection mold as shown in the added reference, for molding the seals of the primary reference, as an equivalent alternative method of applying seals to the filter.

With respect to claims 29, 30, note that the cited primary reference teaches the claimed materials as conventional in the art; see col. 1, lines 50-65.

With respect to claims 35, 42, 47, 48, note that the preferred embodiment of the secondary reference discloses injection molding; see col. 9, lines 8-15.

With respect to claims 31-34 and 44-46, note that the height and shape of the seal is deemed an article design choice, well within the level of ordinary skill in the art.

With respect to claim 49, note that the secondary reference teaches assembly of a filter unit at col. 9, lines 17-27.

### ***Response to Arguments***

Applicant's arguments filed August 2, 2005 have been fully considered but they are not persuasive.

Applicant argues that the reference does not set forth the claimed feature of molding. Applicant further states that the polymer is in the form of putty to limit the spread of the material into the mesh.

Art Unit: 1732

The polymer being in a putty form and shaped to include the disclosed ridges is sufficient to read on the claimed step of molding. Note that the putty being hardened and formed is all that is required to meet this limitation – further, terms such as injection molding, extrusion molding, or the like, are art recognized terms that are much further limiting; the use of ‘molding’ does not require such a standard. Thus this claimed element was not overlooked – it is indeed met by the art and is again applied in this action.

Applicant argues that the ‘627 patent cited fails to show how one forms a gasket in a piece of membrane or a screen per se. Applicant argues that it requires a preformed support, and does not provide motivation.

Reconsideration has been given to this argument, however the reference is deemed particularly pertinent for showing a mold 84, 85 for molding thermoplastic seals 91 around the periphery of an aperture. One of ordinary skill in the art would have been motivated to mold any type of seal for supplying a molded form around a periphery.

### ***Allowable Subject Matter***

Claims 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and overcome the rejection under 112.

Claims 50-52 are allowed.

Applicant must overcome the new matter objection before the case will be issued.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

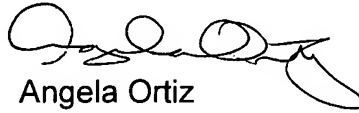
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Angela Ortiz  
Primary Examiner  
Art Unit 1732

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